

REMARKS

Claim 1 has been amended to include the limitation of claim 3, i.e., that an amount of γ -butyrolactone in the nonaqueous solvent is not less than 95 % by volume, and claim 3 has been canceled. Claims 2, 6 and 8 have also been canceled for consistency with the amendment to claim 1.

Claim 7 has been amended to correct an error. Amended claim 7 recites that "not greater than 5 % by volume of ethylene carbonate is contained in the nonaqueous electrolyte." This amendment is supported by the description in paragraph [0022] of the specification of the present application.

In the action, claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2004/0101763 (hereinafter: "Kotato") in view of U.S. Patent No. 6,022,518 (hereinafter: "Yamazaki"). Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotato in view of Yamazaki as applied to claim 1 above, and further in view of JP 2001-297794 (hereinafter: "Kotado").

Applicants respectfully submit that the amendments to claim 1 overcome the 35 U.S.C. § 103 rejections. Kotato requires that the nonaqueous electrolyte include ethylene carbonate in an amount of 10% by volume of more (see paragraph [0017]). Therefore, Kotato

cannot be modified to include an amount of γ -butyrolactone of not less than 95% by volume or not less than 97% by volume in the nonaqueous electrolyte as recited in amended claim 1 and claim 4, respectively. The amount of ethylene carbonate of Kotato also does not encompass or overlap the amount of ethylene carbonate of not greater than 5% by volume in the nonaqueous electrolyte as recited in claim 7 of the present application.

The Office identifies Kotato as disclosing an amount of γ -butyrolactone in the nonaqueous electrolyte of between 50 and 95% by volume. The Office is not correct. Paragraph [0006], cited by the Office as disclosing an amount of γ -butyrolactone of between 50 and 95% by volume, relates to prior art with respect to Kotato and not to the invention of Kotato.

As noted above, Kotato requires that the nonaqueous electrolyte include ethylene carbonate in an amount of 10% by volume or more. Modifying the nonaqueous electrolyte of Kotato to include an amount of γ -butyrolactone of not less than 95% by volume would destroy the invention on which Kotato is based and is improper. (See *Ex parte Hartmann*, 186 USPQ 366 (Bd. App. 1974)).

Removal of the 35 U.S.C. 103(a) rejections of the claims is believed to be in order and is respectfully requested.

PATENT APPLN. NO. 10/792,281
RESPONSE UNDER 37 C.F.R. §1.111

**PATENT
NON-FINAL**

The foregoing is believed to be a complete and proper response to the Office Action dated March 7, 2007, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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